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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/619,511

07/16/2003

Kazuya Katoh

24-008

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23400 7590 11/06/2007  
POSZ LAW GROUP, PLC  
12040 SOUTH LAKES DRIVE  
SUITE 101  
RESTON, VA 20191

EXAMINER

AHMAD, NASSER

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

11/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/619,511	Applicant(s) KATOH ET AL.	
	Examiner Nasser Ahmad	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-9, 11-14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/10/2007 has been entered.

### ***Rejections Withdrawn***

2. Claims 1-4, 7-9, 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Converse (2800215) made in the Office Action of 4/13/2007 has been withdrawn in view of the amendment filed on 8/23/2007.

3. Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Converse made in the Office Action of 4/13/2007 has been withdrawn in view of the amendment filed on 8/23/2007.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-4, 7-9, 11-14, 16 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-4, 7-9, 11-14, 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 3, the negative phrase "wherein the second surface of the base material between the protective material is not an adhesive" is found to be new matter for lack of support for said phrase. Applicant is informed that said negative phrase is an attempt by the applicant to claim what the applicant did not invent.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-4, 7-9, 11-14, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1 and 3, the phrase "wherein the second surface of the base material between the protective material is not an adhesive" is found to be vague and indefinite because it is not clear as to what is encompassed by said negative phrase.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 7-9, 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Converse (2800215).

Converse relates to a laminate sheet (figure-3) comprising a long release sheet (15), an adhesive layer (11a) in continuous direct contact and coextensive with the release surface of the long release sheet (figure-1), a base material (10a) having a first surface and a second surface, the first surface being opposite to the second surface, the first surface being in continuous direct contact and coextensive with the adhesive layer opposite to the long release sheet, the base material being of a different material than the adhesive layer (col. 2, lines 45-64, wherein the base material can be fabric or paper and the adhesive can be rubber, etc.), and a protective material (14a) provided longitudinally on and in continuous direct contact with a generally peripheral portion of the second surface of the base material (figure-1), wherein the peripheral portion

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corresponds to a portion other than a principally used portion of the adhesive layer (because the protective layer **14a** extends only partially along the width). As shown in figures 2 or 4, the protective material is provided on both sides of the second surface of the base material spaced apart in the widthwise direction thereof, wherein the second surface of the base material between the protective material is not adhesive (adhesive #13 is different from the tacky material #12a or 12b).

Figure-1 shows (for claim 2) that a central portion of the adhesive layer in the widthwise direction thereof is the principally used portion of the adhesive layer.

For claim 3, the protective material is in continuous direct contact with a generally peripheral portion of the back surface of the long release sheet (because the protective material **14a** is in contact as shown in figure-1) wherein the peripheral portion corresponds to a portion other than a principally used portion of the adhesive layer.

Claim 4, as explained herein above for claim 2, a central portion of the adhesive layer in the widthwise direction thereof is the principally used portion of the adhesive layer.

Regarding claim 7, the laminate is wound into a roll (figure-5), the protective material serves as a spacer between the base material and long release sheet.

For claims 8 and 13, the protective material has a band like shape and a uniform width (figure-5).

Regarding claims 9 and 14, an edge of the protective material is adjacent to the principally-used portion (figure-5).

For claim 12, the laminate is wound into a roll (figure-5).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Converse.

Converse, as discussed above, fails to expressly teach that the thickness of the protective material is between 5 and 100 microns. It would have been obvious to one having ordinary skill in the art to provide Converse's laminate to have a 5-100 microns protective material because it is well known and conventional in the adhesive art to provide protective material covering the adhesive to have a thickness of between 5 and 100 microns, based on optimization through routine experimentation, for minimizing cost as the protective material is discarded as waste.

***Response to Arguments***

13. Applicant argues that Converse fails to teach that the "the second surface of the base material between the protective material is not an adhesive". This is not found to be convincing because Converse teaches that the tacky layer is located in the central portion of the second surface of the base material and said tacky material is different from the adhesive layer located thereunder, as shown in the drawings, particularly figure-4.

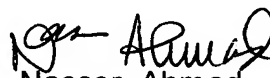
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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad 11/5/07  
Primary Examiner  
Art Unit 1794

N. Ahmad.  
November 5, 2007.